

**O/1211/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003991897  
BY COMMSMASTERS CONSULTING LTD TO REGISTER:**

**COMMSMASTERS**

**AS A TRADE MARK IN CLASSES 9, 35 AND 41**

**AND**

**IN THE MATTER OF AN OPPOSITION THERETO  
UNDER NO. 446022**

**BY COMMSMASTER LTD**

## **Background & Pleadings**

1. On 14 December 2023, CommsMasters Consulting Ltd (“the applicant”) applied to register “COMMSMASTERS” as a trade mark in the United Kingdom. The applicant seeks registration for the following goods and services:

*Computer software; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; training guides in electronic format; training manuals in electronic format; training manuals in the form of a computer program; none of the aforesaid relating to sports or sporting events. (class 9)*

*Advertising; business management; business administration; office functions; conducting of internal business communication surveys; services consisting of the registration, collection, transcription, compilation and systemization of written communications and data; business advisory services relating to company performance; advice relating to business management; advising commercial enterprises in the conduct of their business; assistance, advisory services and consultancy with regard to business management; assistance, advisory services and consultancy with regard to business organization; assistance, advisory services and consultancy with regard to business analysis; assistance, advisory services and consultancy with regard to business planning; assistance to commercial enterprises in the management of their business; business advice and information; business advisory and information services; business advisory and consultancy services; business analysis, research and information services; business assistance, management and administrative services; collection and systematization of business data; advice relating to business organisation; advice relating to commercial management; advice relating to personnel management; business information services provided online from a global computer network or the internet; information, advisory and consultancy services in relation to all of the aforesaid services; none of the aforesaid relating to sports or sporting events (class 35)*

*Education; providing of training; entertainment; education services relating to communication skills; provision of instruction relating to communications techniques; teaching services for communication skills; training in communication techniques;*

*advisory services relating to training; arrangement of training courses in teaching institutes; arranging and conducting of training workshops; arranging of competitions for training purposes; arranging of conferences relating to training; arranging of conventions for training purposes; arranging of demonstrations for training purposes; arranging of displays for training purposes; arranging of exhibitions for training purposes; arranging of festivals for training purposes; arranging of presentations for training purposes; arranging of seminars relating to training; arranging professional workshop and training courses; business training; business training consultancy services; business training provided through a game; business training provided through a simulation structure; career counselling [training and education advice]; career information and advisory services (educational and training advice); certification of education and training awards; coaching [training]; commercial training services; computer assisted training services; computer based training; computerised training; conducting training seminars; conducting training seminars for clients; conducting workshops [training]; consultancy services relating to the analysis of training requirements; consultancy services relating to the designing of training courses; consultancy services relating to the training of employees; consultancy services relating to training; consultancy services relating to the education and training of management and of personnel; education services relating to business training; employment training; life coaching (training); management training consultancy services; management training services; organisation of computer related training courses; organisation of conferences relating to training; organisation of seminars relating to training; organisation of symposia relating to training; organisation of training seminars; organisation of training courses; organising of business training; organising of commercial training; personal development training; personnel training; production of video tapes for corporate use in corporate educational training; production of video tapes for corporate use in management educational training; providing facilities for movies, shows, plays, music or educational training; providing of training; providing training courses on business management; provision of education and training; provision of information relating to training; provision of training; provision of training courses; provision of training facilities; provision of training services for business; provision of training services for industry; publication of training manuals; recreation and training services; residential training courses; setting of training standards; staff training services; training consultancy; training courses; training in business management;*

*training in business skills; training services related to business; training services relating to management consultancy; written training courses; workshops for training purposes; business educational services; tuition in business; publication of work manuals for business management; educational services relating to business; conducting of educational courses relating to business management; conducting of educational courses in business; practical training services; coaching in economic and management matters; conducting of courses relating to business management; computer based educational services in the field of business management; conducting of educational courses in business management; education services relating to management; production of course material distributed at management courses; design of educational courses, examinations and qualifications; providing online electronic publications; online electronic publishing of books and periodicals; information, advisory and consultancy services in relation to all of the aforesaid services; none of the aforesaid relating to sports or sporting events (class 41) <sup>1</sup>*

2. The application was published for opposition purposes on 2 February 2024 and, on 23 February 2024, CommsMaster Ltd (“the opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at all goods and services for which registration is sought. For the purpose of the opposition, the opponent relies upon the following mark and all goods for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 3908312



Filing date: 5 May 2023

Registration date: 28 July 2023

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<sup>1</sup> The applicant’s specification was limited by virtue of filing a Form TM21B on 13 March 2024. In an email of 21 March 2024, the opponent confirmed that the opposition was maintained.

*Telephone switchboards; Telephone cables; Telephone recorders; Wires (Telephone - ); Telephone wires; Telephone intercom apparatus; Telephone modems; Telephone headsets; Radio telephone instruments; Telephone connectors; Telephone transmitters; Telephone earpieces; Telephone apparatus; Telephone terminals; Telephone adapters; Telephone answering apparatus; Telephone terminal; Telephone answering machines; Telephone concentrators; Electronic telephone exchange apparatus; Digital telephone switching apparatus; Terminals for telephone networks; Digital telephone platforms and software; Telephone connecting cords; Telecommunications switchboards; Telephone wire connection boxes; Telephone sets.*  
(class 9)

3. Under the provisions laid out in section 6 of the Act, the opponent's trade mark qualifies as an earlier mark. In accordance with section 6A of the Act, as it had not completed its registration procedure more than five years prior to the filing date of the applicant's mark it is, consequently, not subject to the proof of use requirements. The opponent can therefore rely upon its mark and all goods for which it is registered without providing evidence of use.

4. By virtue of filing an opposition under section 5(2)(b), the opponent claims that there is a likelihood of confusion between the parties' trade marks. In regard to the respective goods and services, in its statement of grounds the opponent writes: "Both companies deal with technology and communications".

5. In its counterstatement, the applicant contends that the parties' marks are "distinct" with "fundamental differences" and that the goods and services are neither identical nor similar, such that there exists no likelihood of confusion.

6. During the evidence rounds, the opponent filed written submissions<sup>2</sup> and the applicant filed evidence. Neither party requested a hearing and only the applicant elected to file written submissions in lieu<sup>3</sup>. This decision is taken following a careful perusal of the papers.

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<sup>2</sup> Filed on 18 October 2024 (Amended)

<sup>3</sup> Filed on 10 March 2025

7. The opponent is represented by James Cox and the opponent by Heather Campbell.<sup>4</sup>

## Relevance of EU Law

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## The applicant's evidence

9. The applicant's evidence comprises a witness statement from its director, Ms Heather Campbell, and nine accompanying exhibits (HC1-HC9). Ms Campbell's statement is dated 23 December 2024.

10. I take the following from the applicant's evidence:

- Since 2013, the applicant has used its CommsMasters mark on course notes and programmes, for advertising and marketing and in all client paperwork including proposals and invoices. Below is an example of the mark used on the applicant's website:



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<sup>4</sup> Both parties have appointed representatives for the purpose of the proceedings. However, I note that the addresses of the party itself and the respective representative are the same. In the applicant's case, its representative (Heather Campbell) appears to be its director. Where applicable, I will proceed on the basis that neither party is represented by a professional legal representative.

- The applicant offers coaching, consulting and training in business leadership, specifically focusing on communication-related matters such as performance management conversations, influencing and confident communication.

- The mark is shown in literature such as brochures and reports and resources from the applicant's website, with examples reproduced below. The applicant's brand name features in all online videos and documents used within its online programmes. The total amount invested in such programmes is around £80,000.



- Ms Campbell submits that the contested mark is recognised on social media platforms such as LinkedIn (12,889 followers) and Instagram (11,400 followers).

- The applicant's annual turnover exceeded £300k in trading years 2018, 2019, 2020, 2023 and 2024.

11. That concludes my summary of the applicant's evidence, insofar as I consider it necessary.

### **Section 5(2)(b)**

12. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there

exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. Section 5A of the Act reads as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

### **Section 5(2)(b) - Case law**

14. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles:**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Preliminary point**

15. For completeness, I wish to deal briefly with a point raised in the opponent's submissions. The opponent alleges that:

"I had been aware of the similarities of our business some years ago especially when clients indicated that search engine results with GOOGLE showed up both businesses."

The above claim is not substantiated to any extent. By my interpretation, the instances referred to are not necessarily examples of *confusion*, but simply a third party acknowledgement that an (undisclosed) search entry may have generated both parties' business information. A single claim of this nature is not compelling and is not sufficient to support a finding of a likelihood of confusion.

### **Comparison of goods and services**

16. The goods and services to be compared are laid out at paragraphs 1 and 2 to this decision.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>5</sup>, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

18. In my comparison of the parties' goods and services, I will consider factors including their nature, intended purpose, method of use, trade channels and whether they are in competition or are complementary.<sup>6</sup>

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<sup>5</sup> Case T-133/05

<sup>6</sup> *Canon*, Case C-39/97; *Treat*, [1996] R.P.C. 281

19. In *Kurt Hesse v OHIM*,<sup>7</sup> the Court of Justice of the European Union (“CJEU”) stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>8</sup>, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

20. In *Sanco SA v OHIM*<sup>9</sup>, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*<sup>10</sup>:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

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<sup>7</sup> Case C-50/15 P

<sup>8</sup> Case T-325/06

<sup>9</sup> Case T-249/11

<sup>10</sup> BL O/255/13

21. The opponent has not addressed any specific factors to support a finding of similarity between the parties' respective specifications. In its statement of grounds it simply says, as above, that "both companies deal with technology and communications". It does little to expand on the matter in its submissions, but I reproduce what may be considered relevant below:

"I would strongly disagree that the two businesses are completely different... I have only acquired the Trademark for CLASS 9 as I felt that this covers the 'engineering side' and hardware of my business, the applicant has applied for several classes of Trademark including CLASS 9, the applicant claims they are a 'Management and training company' which therefore do not require Trademark Classes that infringe on my business nature."

22. I should start by making clear that goods or services are not automatically to be considered similar simply because they are proper to the same class. I will refer to the factors identified above when approaching my assessment.

23. In respect of the parties' goods and services, in the applicant's submissions in lieu it states:

**"1. Geographic and Market Scope**

The opponent operates within the UK, focussing on selling/reselling Voice over IP (VoIP) and telecommunications solutions.

The applicant operates in global markets, targeting senior executives and organisations seeking leadership development and professional consulting services.

This clear separation of:

- Target audiences** (executives vs. telecommunications customers),
- Geographic focus** (global vs. UK-based), and
- Business offerings** (leadership consulting vs. technical solutions)

eliminates any reasonable likelihood of confusion.

## **2. Absolute Distinction Between Goods and Services**

### **-The Applicant (CommsMasters Consulting Ltd):**

Provides executive consulting, coaching, and leadership development specialising in communication strategies for senior leaders.

### **-The Opponent (CommsMaster Ltd):**

Sells/resells telecommunications hardware and VoIP products.

The applicant submits that there is an absolute distinction between goods and services provided by the respective parties.”

24. I can address most of these considerations fairly briefly. In the context of registering or protecting a new mark it is necessary to consider all of the circumstances in which the mark applied for might be used, should it be registered.<sup>11</sup> Differences between parties' *current* offerings are therefore irrelevant to the assessment I am required to make, except to the extent that those differences are apparent from the lists of goods or services they have tendered for the purpose of registration. Furthermore, consideration of a likelihood of confusion is prospective and should not be restricted to the current marketing or trading patterns of the parties.<sup>12</sup> As parties' marketing strategies are transitional and can change with the passage of time, it would be inappropriate to take such factors into account when approaching the prospective analysis of a likelihood of confusion.<sup>13</sup> In short, I am required to make an assessment of the likelihood of confusion notionally and objectively, on the basis of the respective specifications (and marks) as they appear before me.

25. For the purpose of a comparison it is permissible to group services together, where appropriate.<sup>14</sup>

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<sup>11</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

<sup>12</sup> *Oakley v OHIM*, Case T-116/06

<sup>13</sup> *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

<sup>14</sup> *Separode Trade Mark* BL O-399-10 (AP)

*Magnetic data carriers; recording discs; other digital recording media; none of the aforesaid relating to sports or sporting events (class 9)*

26. I consider the above terms against goods such as the opponent's *telephone recorders*, which are proper to the same class. Whilst the nature or context is not specified in the applicant's terms, both parties' goods will be used, broadly speaking, for the purpose of recording data (audio, for example). For the most part, the goods are likely to share users and, given the similarity in use, there may be some similarity in their physical nature, albeit limited. It seems likely that there may be some opportunity for coincidence in the goods' trade channels, though not exclusively. I have nothing to indicate that the goods are indispensable to one another, nor do I find them likely to be competitive, though I accept that there may be circumstances whereby the applicant's goods could be used in the same setting, or in a similar context, as those relied upon by the opponent. Weighing all considerations, and applying due weight to the relevant factors, I find the goods share a low degree of similarity.

*Compact discs, DVDs; none of the aforesaid relating to sports or sporting events (class 9)*

27. Whilst I accept that, similarly to the goods discussed above, the applicant's goods can be used for the purpose of capturing data, to my mind these are unlikely to be used in the same or similar setting as the opponent's goods so their immediate use is likely different. There may be a broad overlap in the goods' users and, whilst they share an overriding functionality, they are physically distinct. The trade channels are unlikely to be shared and the goods are not competitive. I do not consider the goods to be complementary. On balance, I find the goods are dissimilar.

*Computer software; none of the aforesaid relating to sports or sporting events. (class 9)*

28. The opponent relies upon *digital telephone platforms and software*. It may be that the respective goods should be deemed identical in accordance with *Meric*. However, I will go on to consider the relevant factors, should there be a distinction to be made between the goods on the basis that one is *computer software* and the other *digital*

software. The applicant's computer software is fairly broad (notwithstanding its limitation) and, whilst I am mindful not to allow too wide a protection,<sup>15</sup> it could naturally encompass software utilised for a similar purpose to the relied-upon goods. In such circumstances, there would be a significant overlap in the goods' nature, use and in their respective users. The goods would likely utilise the same trade channels, it would not seem unreasonable for the consumer to expect a single undertaking to offer both and the goods may be competitive. I find these goods are (at least) highly similar.

*Training manuals in the form of a computer program; training guides in electronic format; training manuals in electronic format; none of the aforesaid relating to sports or sporting events. (class 9)*

29. With regard to the above goods, I can see little meaningful similarity between these and the goods relied upon. The goods' use is distinct; the opponent's goods (in broad terms) will enable the user to communicate via telephone, whereas the aforementioned goods will be accessed by users wishing to undertake a specific area of training. Any coincidence in the goods' users is likely to be at a very high level and the goods' nature is distinct. To my mind, the trade channels are unlikely to be shared and the goods are not competitive nor complementary. I find the goods dissimilar.

*Advertising; business management; business administration; conducting of internal business communication surveys; services consisting of the registration, collection, transcription, compilation and systemization of written communications and data; business advisory services relating to company performance; advice relating to business management; advising commercial enterprises in the conduct of their business; assistance, advisory services and consultancy with regard to business management; assistance, advisory services and consultancy with regard to business organization; assistance, advisory services and consultancy with regard to business analysis; assistance, advisory services and consultancy with regard to business planning; assistance to commercial enterprises in the management of their business; business advice and information; business advisory and information services; business advisory and consultancy services; business analysis, research and information*

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<sup>15</sup> *Sky v Skykick* [2020] EWHC 990 (Ch)

*services; business assistance, management and administrative services; collection and systematization of business data; advice relating to business organisation; advice relating to commercial management; advice relating to personnel management; information, advisory and consultancy services in relation to all of the aforesaid services; none of the aforesaid relating to sports or sporting events (class 35)*

30. I can see no meaningful similarity between the goods relied upon by the opponent and the services set out above. There may be some degree of coincidence in the users of the respective goods and services but the respective uses are distinct. The goods and services are not similar in nature and the trade channels through which they reach the market are likely disparate. Whilst of course I accept that telephone apparatus may be used in a business setting, this does not amount to what I consider to be a complementary relationship, certainly not to an extent that the consumer would believe them to originate from the same undertaking. Further, the goods and services are not competitive. Weighing all considerations, I do not consider the goods and services to be similar.

*Office functions; none of the aforesaid relating to sports or sporting events (class 35)*

31. The explanatory note for class 35 of the Nice Classification provides some insight as to the kinds of services likely to be encompassed by *office functions*. It reads: "...office functions, for example, appointment scheduling and reminder services, data search in computer files for others, computerized file management, telephone switchboard services" (my emphasis). I therefore consider this term against the opponent's *telephone switchboards*. There is an inevitable distinction in the nature of the goods against the services, though there is likely some overlap in the respective users and there is an overarching coincidence in the purpose of the respective goods and services. Whilst the trade channels may, for the most part, be distinct, there could be an opportunity for competitiveness in circumstances whereby, for example, a business is choosing whether or not to purchase a switchboard for self-operation or purchase the wider service from a third party. I also find complementarity between the provision of telephone switchboards, as a service, and the equipment itself, insofar as they are indispensable. It would also not seem unreasonable for the average consumer to expect the same undertaking, or a related undertaking, to offer both the goods and

services, given the nature of the relationship between them (though I accept this may not always be the case). Weighing all findings, I consider there to be a low degree of similarity.

*Business information services provided online from a global computer network or the internet; none of the aforesaid relating to sports or sporting events*

32. Other than each relying on a network of some description, I can see no more meaningful similarity between the goods relied upon and the services outlined above. Even where the earlier goods are used in a business-environment, the goods and services' respective uses are distinct. There may be a broad coincidence in the respective users but the goods and services are unlikely share trade channels and there is no similarity in their nature. I do not consider the goods and services competitive nor are they complementary. On balance, I do not consider the goods and services to be similar.

*Education; providing of training; education services relating to communication skills; provision of instruction relating to communications techniques; teaching services for communication skills; training in communication techniques; advisory services relating to training; arrangement of training courses in teaching institutes; arranging and conducting of training workshops; arranging of competitions for training purposes; arranging of conferences relating to training; arranging of conventions for training purposes; arranging of demonstrations for training purposes; arranging of displays for training purposes; arranging of exhibitions for training purposes; arranging of festivals for training purposes; arranging of presentations for training purposes; arranging of seminars relating to training; arranging professional workshop and training courses; business training; business training consultancy services; business training provided through a game; business training provided through a simulation structure; career counselling [training and education advice]; career information and advisory services (educational and training advice); certification of education and training awards; coaching [training]; commercial training services; computer assisted training services; computer based training; computerised training; conducting training seminars; conducting training seminars for clients; conducting workshops [training]; consultancy services relating to the analysis of training requirements; consultancy services relating*

*to the designing of training courses; consultancy services relating to the training of employees; consultancy services relating to training; consultancy services relating to the education and training of management and of personnel; education services relating to business training; employment training; life coaching (training); management training consultancy services; management training services; organisation of computer related training courses; organisation of conferences relating to training; organisation of seminars relating to training; organisation of symposia relating to training; organisation of training seminars; organisation of training courses; organising of business training; organising of commercial training; personal development training; personnel training; production of video tapes for corporate use in corporate educational training; production of video tapes for corporate use in management educational training; providing facilities for movies, shows, plays, music or educational training; providing of training; providing training courses on business management; provision of education and training; provision of information relating to training; provision of training; provision of training courses; provision of training facilities; provision of training services for business; provision of training services for industry; publication of training manuals; recreation and training services; residential training courses; setting of training standards; staff training services; training consultancy; training courses; training in business management; training in business skills; training services related to business; training services relating to management consultancy; written training courses; workshops for training purposes; business educational services; tuition in business; publication of work manuals for business management; educational services relating to business; conducting of educational courses relating to business management; conducting of educational courses in business; practical training services; coaching in economic and management matters; conducting of courses relating to business management; computer based educational services in the field of business management; conducting of educational courses in business management; education services relating to management; production of course material distributed at management courses; design of educational courses, examinations and qualifications; providing online electronic publications; online electronic publishing of books and periodicals; information, advisory and consultancy services in relation to all of the aforesaid services; none of the aforesaid relating to sports or sporting events (class 41)*

33. Whilst I acknowledge that some of the aforementioned services specify a use in relation to *communication skills* (and that some of the broader terms may also naturally include use in this field), I nonetheless find the use of the services and the goods relied-upon is different. Generally speaking, the opponent's goods enable communication specifically via telephone apparatus. Services concerning *communication skills* and *communication techniques*, for example, to my mind, are more likely to refer to a wider means of communication whereby users learn how to more effectively interact (with peers or colleagues, for example). Even where this is not the case, the respective uses seem nonetheless distinct. Any coincidence in the users of the parties' goods and services is likely to be at a fairly high level. To my mind, there is unlikely to be any coincidence in nature nor trade channels, the goods and services are not competitive and I do not consider there to be a complementary dynamic. I have considered whether there is a complementary element in circumstances whereby the aforementioned communication skills or techniques do, in fact, refer to tangible means or methods of communication, rather than interpersonal communication, and whether this considered against the opponent's goods, would give rise to an indispensable dynamic, but I do not take the view that the average consumer would consider the services to originate from a single undertaking.<sup>16</sup> Having due regard to the relevant factors, I find no similarity.

*Entertainment; none of the aforesaid relating to sports or sporting events*

34. Beyond any broad opportunity for the same users, I can see no similarity between the relied-upon goods and the applicant's *entertainment* services. The goods and services do not share a use, the respective trade channels are distinct and I see no opportunity for similarity in nature. The goods and services are not complementary nor are they competitive. I find the goods and services dissimilar.

35. As some degree of similarity is necessary to engage a likelihood of confusion<sup>17</sup>, the opposition must fail at this juncture in respect of the goods and services which I have found to be dissimilar. The opposition therefore proceeds only in relation to the goods and services which I have found to be similar, namely those laid out below:

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<sup>16</sup> See, for example, *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13

<sup>17</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

*Magnetic data carriers; recording discs; other digital recording media; computer software; none of the aforesaid relating to sports or sporting events (class 9)*

*Office functions; none of the aforesaid relating to sports or sporting events (class 35)*

### **The average consumer and the nature of the purchasing act**

36. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question<sup>18</sup>. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

37. The average consumer of the goods which remain at issue is likely to comprise both members of the general public and professional bodies such as businesses or organisations. To my mind, the goods are likely to be selected either from a tangible retail outlet or online equivalent, or from a dedicated catalogue. The marks' visual impression is therefore likely to play the greatest role in the selection process, though I do not overlook the relevance of the aural position. Consumers are likely to be alive to factors such as capacity and compatibility when approaching the purchase. The cost, to my knowledge, is not of a particularly high degree (though I accept that there may be exceptions, particularly on the part of the professional consumer) and the purchase will

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<sup>18</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

not necessarily be made with any meaningful frequency. Generally speaking, I find the average consumer will pay a medium degree of attention.

38. As for the services, the average consumer is likely to comprise professional undertakings which have a need for, or make use to some extent of, dedicated office functions, including the operation of telephone switchboards. To my mind, the services are likely to be selected from a dedicated journal or catalogue advertising a variety of 'office-based' functions, suggesting that the marks' visual impression will play the greatest part in the services' selection. That said, particularly given that consumers may rely in part on word-of-mouth recommendations, I find the marks' aural impression is also significant, though to a lesser degree. When approaching its selection, the consumer is likely to keep in mind a number of factors to properly assess the services' suitability. I find the level of attention is likely to be of at least a medium degree.


### **Comparison of trade marks**

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. ...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

40. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

41. The trade marks to be compared are displayed in the table below:

Opponent's mark	Applicant's mark
	<b>COMMSMASTERS</b>

42. The opponent's mark combines a number of word elements and a figurative device. Central to the mark is the word COMMSMASTER, in a fairly unremarkable, upper-case typeface. Positioned underneath, on the right-hand side and in a significantly smaller font is a web address, WWW.COMMSMASTER.COM. COMMSMASTER is presented in bright blue and the web address in black. Overlapping the first three letters in the mark's central word is a circular device with an outer swirl-effect, also in blue. Given its respective size within the context of the wider mark, and that it is likely to be perceived simply as the website associated with the undertaking, the address displayed underneath COMMSMASTER makes little, if any, contribution to the mark's overall impression. Whilst the device element plays a role, I find COMMSMASTER is likely to carry the greatest weight in terms of an overall impression. Whilst this element will be perceived as a single word, the consumer is likely to identify two more distinguishable elements: COMMS/MASTER.

43. The applicant's mark comprises only a single word: COMMSMASTERS. In the absence of any additional elements, the mark's overall impression resides solely in the word itself. Given that COMMSMASTERS is not, to my knowledge, an ordinary word with which the average consumer will be familiar, the consumer is likely to naturally dissect it into recognisable elements COMMS and MASTERS as these meanings will be more readily retrievable.

44. Visually, the marks coincide in a ten-letter letter sequence from the earlier mark's COMMSMASTER element and COMMSMASTERS in the later mark. The only

difference between these respective words is the addition and/or absence of a letter S, which represents the final letter in the applicant's mark. In addition to this difference between the respective words, there is also a device element and an additional word element in the earlier mark, which have no counterpart in the applicant's mark. That said, keeping in mind my findings above concerning the marks' respective overall impressions, I find the visual similarity is fairly high.

45. Aurally, the earlier mark is likely to comprise three syllables, with COMMS and MASTER articulated in the usual way. I say this because I find it highly unlikely that the average consumer will attempt to articulate the mark's device element and I do not take the view that the web address in the earlier mark will be verbalised. The later mark is also likely to comprise three syllables, with COMMS and MASTERS given their usual pronunciation. Particularly given that, generally speaking, the beginnings of marks tend to have more of an impact on the consumer than their endings, I find the marks are aurally highly similar.

46. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer in the UK.<sup>19</sup> Beginning with the opponent's mark, conceptually, the average consumer will like identify COMMS and MASTER within its central word element. COMMS is likely to be viewed as a shortening of COMMUNICATIONS and MASTER will be awarded its ordinary meaning. Together, the word creates an impression of an individual who is, to some extent, a master or expert of communications. The device element is unlikely to contribute any conceptual meaning and neither will the web address. I apply much of the same reasoning to my consideration of the applicant's mark. Its distinguishable elements COMMS and MASTERS will convey a message of more than one master, or expert, of communications. Weighing these findings, I find a very high degree of similarity between the marks' respective conceptual impressions.

### **Distinctive character of the earlier trade mark**

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<sup>19</sup> *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

47. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

49. In the absence of evidence showing the use made of the earlier mark, I have only its inherent distinctiveness to consider. For the most part, the goods relied upon concern means of communication. That being so, the conceptual meaning conveyed by the mark could be considered descriptive, or at least allusive, of the relevant goods. The merging of COMMS and MASTER to create a single, invented word awards the mark some distinctiveness but its device element and the web address have little meaningful impact on the distinctiveness of the mark overall. Weighing all considerations, I find the mark enjoys no more than a medium degree of inherent distinctiveness.

### **Likelihood of confusion**

50. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

51. In *Kurt Geiger v A-List Corporate Limited*<sup>20</sup>, Mr Iain Purvis K.C. as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an

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<sup>20</sup> BL O/075/13

aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, “in what does the distinctive character of the earlier mark lie?” Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

52. Confusion can be direct or indirect. I take note of the comments made by Mr Iain Purvis K.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*<sup>21</sup>, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply

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<sup>21</sup> BL O/375/10

even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

53. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*<sup>22</sup>, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*<sup>23</sup>, where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

55. I begin by considering a likelihood of direct confusion. As the case law suggests, this is a simple matter of the average consumer mistaking one trade mark for the other. I have found the marks' visual similarity is fairly high and that the marks' visual weight plays the greatest role in the selection process. I have not discounted the significance of the marks' aural impression and have found the marks' aural similarity is of a high degree. To my mind, notwithstanding the degree of inherent distinctiveness attributed to the earlier mark, the similarity between the parties' marks is such that, even a low level of similarity between the relevant goods or services would give rise to a likelihood of confusion whereby the average consumer erroneously believes that the marks are

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<sup>22</sup> [2021] EWCA Civ 1207

<sup>23</sup> BL O/219/16

the same, as per the effects of the interdependency principle. The consumer is likely to mis-recall whether or not COMMSMASTER is presented in the singular or plural form in the respective marks and, given the nature of the additional elements in the earlier mark, it seems likely that these could be overlooked, on a repeat purchase, for example. I consider this a likely outcome even where the consumer applies a higher than medium degree of attention to its purchase. I find there is a likelihood of direct confusion.

56. In the alternative, were the marks' differences to be identified, I nonetheless find it unlikely that the variation in COMMSMASTER/COMMSMASTERSU will be recalled by the average consumer. The marks' remaining differences, specifically the device element and the web address which are present in the earlier mark, are likely to be attributed to an evolutionary development of an existing brand or redesign, for example. In other words, when considered in respect of similar goods or services, even those which are similar to a low degree, I find the average consumer will erroneously conclude that the marks originate from a single or economically-linked undertaking. Whilst I have kept in mind throughout that the earlier mark enjoys no more than a medium degree of inherent distinctiveness, and I remind myself that a *proper basis* is required, in light of the above considerations I find there is a likelihood of indirect confusion.

## **Conclusion**

**57. The opposition has succeeded, in part. Subject to any successful appeal, the application will be refused in respect of:**

*Magnetic data carriers; recording discs; other digital recording media; computer software; none of the aforesaid relating to sports or sporting events (class 9)*

*Office functions; none of the aforesaid relating to sports or sporting events (class 35)*

**58. The opposition has failed in respect of the remaining goods and services. Subject to any successful appeal, the application will proceed to registration for:**

*Compact discs, DVDs; training guides in electronic format; training manuals in electronic format; training manuals in the form of a computer program; none of the aforesaid relating to sports or sporting events. (class 9)*

*Advertising; business management; business administration; conducting of internal business communication surveys; services consisting of the registration, collection, transcription, compilation and systemization of written communications and data; business advisory services relating to company performance; advice relating to business management; advising commercial enterprises in the conduct of their business; assistance, advisory services and consultancy with regard to business management; assistance, advisory services and consultancy with regard to business organization; assistance, advisory services and consultancy with regard to business analysis; assistance, advisory services and consultancy with regard to business planning; assistance to commercial enterprises in the management of their business; business advice and information; business advisory and information services; business advisory and consultancy services; business analysis, research and information services; business assistance, management and administrative services; collection and systematization of business data; advice relating to business organisation; advice relating to commercial management; advice relating to personnel management; business information services provided online from a global computer network or the internet; information, advisory and consultancy services in relation to all of the aforesaid services; none of the aforesaid relating to sports or sporting events (class 35)*

*Education; providing of training; entertainment; education services relating to communication skills; provision of instruction relating to communications techniques; teaching services for communication skills; training in communication techniques; advisory services relating to training; arrangement of training courses in teaching institutes; arranging and conducting of training workshops; arranging of competitions for training purposes; arranging of conferences relating to training; arranging of conventions for training purposes; arranging of demonstrations for training purposes; arranging of displays for training purposes; arranging of exhibitions for training purposes; arranging of festivals for training purposes; arranging of presentations for training purposes; arranging of seminars relating to training; arranging professional workshop and training courses; business training; business training consultancy*

*services; business training provided through a game; business training provided through a simulation structure; career counselling [training and education advice]; career information and advisory services (educational and training advice); certification of education and training awards; coaching [training]; commercial training services; computer assisted training services; computer based training; computerised training; conducting training seminars; conducting training seminars for clients; conducting workshops [training]; consultancy services relating to the analysis of training requirements; consultancy services relating to the designing of training courses; consultancy services relating to the training of employees; consultancy services relating to training; consultancy services relating to the education and training of management and of personnel; education services relating to business training; employment training; life coaching (training); management training consultancy services; management training services; organisation of computer related training courses; organisation of conferences relating to training; organisation of seminars relating to training; organisation of symposia relating to training; organisation of training seminars; organisation of training courses; organising of business training; organising of commercial training; personal development training; personnel training; production of video tapes for corporate use in corporate educational training; production of video tapes for corporate use in management educational training; providing facilities for movies, shows, plays, music or educational training; providing of training; providing training courses on business management; provision of education and training; provision of information relating to training; provision of training; provision of training courses; provision of training facilities; provision of training services for business; provision of training services for industry; publication of training manuals; recreation and training services; residential training courses; setting of training standards; staff training services; training consultancy; training courses; training in business management; training in business skills; training services related to business; training services relating to management consultancy; written training courses; workshops for training purposes; business educational services; tuition in business; publication of work manuals for business management; educational services relating to business; conducting of educational courses relating to business management; conducting of educational courses in business; practical training services; coaching in economic and management matters; conducting of courses relating to business management; computer based educational services in the field of business management; conducting of educational*

*courses in business management; education services relating to management; production of course material distributed at management courses; design of educational courses, examinations and qualifications; providing online electronic publications; online electronic publishing of books and periodicals; information, advisory and consultancy services in relation to all of the aforesaid services; none of the aforesaid relating to sports or sporting events (class 41)*

## **Costs**

59. Both parties have achieved a measure of success, with the greater part going to the applicant, who would therefore be entitled to a contribution towards its costs. Given that the applicant is not represented by a professional legal representative, at the end of the evidence rounds it was invited to file a costs pro-forma should it wish to make a request for costs in respect of the proceedings. The relevant part from the official letter issued on 13 February 2025 reads as follows:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk).

If there is to be a “decision from the papers” this should be provided by 13 March 2025.

...

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

60. As the pro-forma was not returned by the applicant, given that no official fees were incurred, I decline to make an award of costs.

**Dated this 23<sup>rd</sup> day of December 2025**

**Laura Stephens  
For the Registrar**